



IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

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Nikhil M. Deshpande

Title: PERSONAL ASSISTANCE SERVICE WITH INSTANT MESSAGING

Docket No.: 884.493US1

Serial No.: 09/940,755

Filed: August 28, 2001

Due Date: December 14, 2005

Examiner: Kimberly D Flynn

Group Art Unit: 2152

MS Appeal Brief - Patents

Commissioner for Patents

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(GENERAL)



PATENT

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of: Nikhil M. Deshpande

Examiner: Kimberly D. Flynn

Serial No.: 09/940,755

Group Art Unit: 2152

Filed: August 28, 2001

Docket: 884.493US1

For: PERSONAL ASSISTANCE SERVICE WITH INSTANT MESSAGING

Assignee: Intel Corporation

APPEAL BRIEF UNDER 37 CFR § 41.37

Mail Stop Appeal Brief- Patents
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P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

The Appeal Brief is presented in support of the Notice of Appeal to the Board of Patent Appeals and Interferences, filed on October 14, 2005, from the Final Rejection of claims 1-25 of the above-identified application, as set forth in the Final Office Action mailed on July 14, 2005.

The Commissioner of Patents and Trademarks is hereby authorized to charge Deposit Account No. 19-0743 in the amount of 500.00 which represents the requisite fee set forth in 37 C.F.R. § 41.2(b)(2). The Appellants respectfully request consideration and reversal of the Examiner's rejections of pending claims.

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APPEAL BRIEF UNDER 37 C.F.R. § 41.37

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1. REAL PARTY IN INTEREST

The real party in interest of the above-captioned patent application is the assignee, INTEL CORPORATION, a Delaware corporation doing business at 2625 Walsh Avenue, Santa Clara, CA 95051, in an assignment recorded on August 28, 2001 (Reel/Frame 012132/0671-0673).

2. RELATED APPEALS AND INTERFERENCES

There are no other appeals, interferences, or judicial proceedings known to the appellant which will have a bearing on the Board's decision in the present appeal.

3. STATUS OF THE CLAIMS

Claims 1-25 are pending in the application, and are rejected. Claims 1-25 are being appealed.

4. STATUS OF AMENDMENTS

No Amendment has been filed by the appellant subsequent to the final Office Action dated July 14, 2005.

5. SUMMARY OF CLAIMED SUBJECT MATTER

The following is a concise explanation of the subject matter defined in each of the independent claims involved in the appeal. Claim elements are identified at least once by reference character and by the page and line in the specification where the element may be found.

Claim 1 recites a method including sending a first immediate message (510, page 12, line 20) from a location, wherein the first immediate message comprises a request for information, and receiving a second immediate message (530, page 13, line 11), wherein the second immediate message comprises a response to the request, wherein the response is dependent on the location.

Claim 4 recites a method including receiving a first instant message (510, page 12, line 20) from a sender, determining a location of the sender, and sending a second instant message (530, page 13, line 11) to the sender, wherein contents of the second instant message are dependent on the location of the sender.

Claim 7 recites a server (160, page 5, line 3) including data indicating a location of a mobile device (140, page 4, line 17) and a personal-assistance controller (260, page 6, line 15) to send information to the mobile device, wherein the information is based on the location of the mobile device.

Claim 12 recites a mobile device (140, page 4, line 17) including a controller (335, page 8, line 9) to contact a hotspot-access point (120, 130, page 3, lines 5-6), send a request for information to a server (160, page 5, line 3) via the hotspot-access point, and receive a response to the request, wherein the response comprises information dependent on a location of the hotspot-access point.

Claim 17 recites an apparatus including an instant-messaging server (160, page 5, line 3) including a personal-assistance controller (260, page 6, line 15), presence data (265, page 6, line 20) including reachability and location information regarding a plurality of mobile devices (140, page 4, line 17), and information regarding services

relative to a plurality of hotspot-access points (120, 130, page 3, lines 5-6). One of the plurality of mobile devices includes a controller (335, page 8, line 9) to connect to one of the plurality of hotspot-access points, send a request to the personal-assistance controller, and receive a response to the request, wherein the response comprises information dependent on a location of the one of the plurality of hotspot-access points.

Claim 22 recites a signal-bearing media (240, page 6, line 15) including instructions, wherein the instructions when read and executed by a processor (235, page 6, line 16) include receiving a first instant message (510, page 12, line 20), determining a location of a sender of the first instant message, and sending a second instant message (530, page 13, line 11) to the sender, wherein contents of the second instant message are dependent on the location of the sender.

6. GROUNDS OF REJECTION TO BE REVIEWED ON APPEAL

I. Claims 1 to 25 stand rejected under 35 USC §103(a) as being unpatentable over Joyce et al. (U.S. 6,798,358, Joyce) in view of Carey et al. (U.S. 6,714,793, Carey).

7. ARGUMENT

The Applicable Law

All of the pending claims were rejected under 35 U.S.C. §103:

“A patent may not be obtained...if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art.”¹

The MPEP states the following with regard to rejections under 35 USC § 103:

“To establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations.”²

The appellant respectfully submits that the final Office Action fails to make a *prima facie* showing of obviousness by failing to show motivation to combine Joyce and Carey and also fails to provide evidence of a reasonable expectation of success of the combination.

A Federal Circuit opinion states that the suggestion or motivation to combine references and the reasonable expectation of success must both be found in the prior art.³

Multiple Federal Circuit decisions emphasize the need for the PTO to furnish evidence in support of claim rejections. For example, the Federal Circuit addressed citation of “basic knowledge or common sense” in rejections in *In re Zurko*:

“With respect to core factual findings in a determination of patentability, however, the Board [Board of Patent Appeals and Interferences] cannot simply reach conclusions based on its own understanding or experience – or on its assessment of what would be basic knowledge or common sense. Rather, the Board must point to some concrete evidence in the record in support of these findings.”⁴

¹ 35 U.S.C. § 103(a).

² MPEP 2143.

³ MPEP 2143 citing *In re Vaeck*, 20 USPQ2d 1438, 1442 (Fed. Cir. 1991).

⁴ *In re Zurko*, 59 USPQ2d 1693, 1697 (Fed. Cir. 2001).

The Federal Circuit has particularly emphasized the need for the PTO to furnish evidence in support of claim rejections under 35 USC § 103 in *In re Lee*:

“When patentability turns on the question of obviousness, the search for and analysis of the prior art includes evidence relevant to the finding of whether there is a teaching, motivation, or suggestion to select and combine the references relied on as evidence of obviousness.....The factual inquiry whether to combine references must be thorough and searching....It must be based on objective evidence of record.”⁵

The Federal Circuit stated that the “need for specificity pervades this authority” requiring a teaching, motivation, or suggestion to select and combine references.⁶ The Federal Circuit has expressed this need for specificity in several cases:

“[T]he best defense against the subtle but powerful attraction of a hindsight-based obviousness analysis is rigorous application of the requirement for a showing of the teaching or motivation to combine prior art references.....the showing must be clear and particular.”⁷

“[E]ven when the level of skill in the art is high, the Board must identify specifically the principle, known to one of ordinary skill, that suggests the claimed combination.”⁸

“[P]articular findings must be made as to the reason the skilled artisan, with no knowledge of the claimed invention, would have selected these components for combination in the manner claimed.”⁹

⁵ *In re Lee*, 61 USPQ2d 1430, 1433 (Fed. Cir. 2002).

⁶ *In re Lee*, 61 USPQ2d 1430, 1433 (Fed. Cir. 2002).

⁷ *In re Dembiczak*, 50 USPQ2d 1614, 1617 (Fed. Cir. 1999).

⁸ *In re Rouffet*, 47 USPQ2d 1453, 1459 (Fed. Cir. 1998).

⁹ *In re Kotzab*, 55 USPQ2d 1313, 1317 (Fed. Cir. 2000).

Rejection

- I. Claims 1 to 25 stand rejected under 35 USC §103(a) as being unpatentable over Joyce et al. (U.S. 6,798,358, Joyce) in view of Carey et al. (U.S. 6,714,793, Carey).

Representative of the rejected claims, claim 1 recites a “method, comprising sending a first immediate message from a location, wherein the first immediate message comprises a request for information and receiving a second immediate message, wherein the second immediate message comprises a response to the request, wherein the response is dependent on the location.”

The applicant respectfully submits that the final Office Action has not identified prior art evidence of a suggestion for combining Joyce with Carey, or evidence of a reasonable expectation of success of this combination.

Joyce relates to location-based content delivery¹⁰ to a mobile terminal 10 serviced by a wireless communication network 12.¹¹ The final Office Action states:

“Joyce does not explicitly disclose that the messages are instant or immediate messages.”¹²

Carey relates to a method and system for instant messaging.¹³

The final Office Action states:

“it would have been obvious ... to modify the system disclosed by Joyce to include instant messaging capabilities in order to

¹⁰ Joyce, Title.

¹¹ Joyce, column 3, lines 6-15.

¹² Final Office Action, page 3.

¹³ Carey, Title.

provide subscribers with the benefits of real-time communication on a constantly open communication channel not only in hardwired Internet systems but also in a wireless environment. It would be advantageous to communicate via instant text message because text messaging as compared to voice communications it is less costly since it utilizes less bandwidth.”¹⁴

The final Office Action has not identified prior art as being the source of the above-quoted rationale for combining Joyce and Carey as is required by *In re Vaeck* and *In re Lee*.

As an example, the final Office Action has not identified prior art showing that communicating with instant text messages is less costly and utilizes less bandwidth. The last paragraph of the background of Carey compares instant messaging with text messaging, and finds that text messaging “uses up much less bandwidth or resources than voice data.”¹⁵ However, this advantage accrues to text messages which are distinguished from instant messaging in the same paragraph of Carey. Carey does not state that the “less bandwidth” advantage accrues to instant messaging in this paragraph.

The final Office Action has also not identified evidence of a reasonable expectation of success for this combination in the prior art as is required by MPEP 2143, *In re Vaeck* and *In re Lee*. The final Office Action has not shown evidence of how the elements of Joyce and Carey are to be arranged and assembled together. The Federal Circuit has stated that all elements of a *prima facie* case of obviousness must be established in a rejection:

“Omission of a relevant factor required by precedent is both legal error and arbitrary agency action.”¹⁶

A *prima facie* case of obviousness can not be established against claims 1-25 without evidence of a reasonable expectation of success.

¹⁴ Final Office Action, page 3.

¹⁵ Carey, column 1, lines 46-58.

¹⁶ *In re Lee*, 61 USPQ2d 1430, 1434 (Fed. Cir. 2002).

The final Office Action is improperly using hindsight in combining Joyce and Carey contrary to *In re Dembiczak*.

Claims 12, 17, 18, and 25

Representative of claims 12, 17, 18, and 25, claim 12 recites a “mobile device, comprising a controller to contact a hotspot-access point, send a request for information to a server via the hotspot-access point, and receive a response to the request, wherein the response comprises information dependent on a location of the hotspot-access point.”

Neither Joyce nor Carey show or describe the claimed hotspot-access point. The final Office Action states that “the hotspot access point is functionally equivalent to the wireless communication network 12.”¹⁷ The final Office Action has not identified prior art evidence as being the source of this assertion about the hotspot access point as is required by *In re Zurko* quoted above.

The applicant respectfully submits that a *prima facie* case of obviousness against claims 1-25 has not been established in the final Office Action, and that claims 1-25 are in condition for allowance.

¹⁷ Final Office Action, page 6.

8. SUMMARY

Request For Reversal

For the foregoing reasons, the appellant respectfully submits that the rejection of claims 1-25 under 35 U.S.C. §103 was erroneous. Reversal of this rejection is respectfully requested, as well as the allowance of all the rejected claims.

If necessary, please charge any additional fees or credit overpayment to Deposit Account No. 19-0743.

Respectfully submitted,

NIKHIL M. DESHPANDE

By his Representatives,

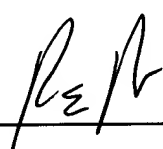
SCHWEGMAN, LUNDBERG,

WOESSNER & KLUTH, P.A.

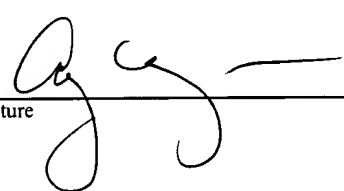
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Name Amy Moriarty Signature 

CLAIMS APPENDIX

1. (Rejected) A method, comprising:

 sending a first immediate message from a location, wherein the first immediate message comprises a request for information; and

 receiving a second immediate message, wherein the second immediate message comprises a response to the request, wherein the response is dependent on the location.

2. (Rejected) The method of claim 1, wherein the sending the first immediate message further comprises sending the first immediate message to a user name identified in a buddy list.

3. (Rejected) The method of claim 2, wherein the user name identifies a program executing on an instant-messaging server.

4. (Rejected) A method, comprising:

 receiving a first instant message from a sender;

 determining a location of the sender; and

 sending a second instant message to the sender, wherein contents of the second instant message are dependent on the location of the sender.

5. (Rejected) The method of claim 4, further comprising:

 parsing contents of the first instant message to determine a meaning of the contents, wherein the contents of the second instant message are further dependent on the meaning.

6. (Rejected) The method of claim 5, further comprising:

finding information related to the meaning of the contents of the first instant message; and

building the contents of the second instant message based on the information.

7. (Rejected) A server, comprising:

data indicating a location of a mobile device; and

a personal-assistance controller to send information to the mobile device,

wherein the information is based on the location of the mobile device.

8. (Rejected) The server of claim 7, wherein the mobile device is connected via a long-lived connection to the instant-messaging server.

9. (Rejected) The server of claim 7, wherein the personal-assistance controller is to send an instant message to the mobile device, wherein the instant message comprises the information.

10. (Rejected) The server of claim 7, further comprising:

a location database comprising the location of the mobile device and the information,

wherein the information is specific to the location.

11. (Rejected) The server of claim 7, wherein the personal-assistance controller is further to:

parse a request from the mobile device to determine a meaning of the request, and

determine the information based on the location of the mobile device and the meaning of the request.

12. (Rejected) A mobile device, comprising:

a controller to contact a hotspot-access point, send a request for information to a server via the hotspot-access point, and receive a response to the request, wherein

the response comprises information dependent on a location of the hotspot-access point.

13. (Rejected) The mobile device of claim 12, wherein the request and the response are both instant messages.

14. (Rejected) The mobile device of claim 12, wherein the request is sent and the response is received over a long-lived connection.

15. (Rejected) The mobile device of claim 12, wherein the controller further is to send the request to a user name identified in a buddy list.

16. (Rejected) The mobile device of claim 15, wherein the user name identifies a program executing on an instant-messaging server.

17. (Rejected) An apparatus, comprising:

- an instant-messaging server comprising
 - a personal-assistance controller,
 - presence data comprising reachability and location information
- regarding a plurality of mobile devices, and
- information regarding services relative to a plurality of hotspot-access

points; and

- wherein one of the plurality of mobile devices comprises:

- a controller to connect to one of the plurality of hotspot-access points,
 - send a request to the personal-assistance controller, and receive a response to the request, wherein the response comprises information dependent on a location of the one of the plurality of hotspot-access points.

18. (Rejected) The apparatus of claim 17, wherein the personal-assistance controller is to determine the location of the one of the plurality of hotspot-access points via the presence data.

19. (Rejected) The apparatus of claim 17, wherein the request and response are both instant messages.

20. (Rejected) The apparatus of claim 17, wherein the instant-messaging server further comprises a buddy list for a user of the mobile device.

21. (Rejected) The apparatus of claim 20, wherein the personal-assistance controller has an associated entry in the buddy list.

22. (Rejected) A signal-bearing media comprising instructions, wherein the instructions when read and executed by a processor comprise:
 receiving a first instant message;
 determining a location of a sender of the first instant message; and
 sending a second instant message to the sender, wherein contents of the second instant message are dependent on the location of the sender.

23. (Rejected) The signal-bearing media of claim 22, wherein the instructions further comprise:
 parsing contents of the first instant message to determine a meaning of the contents, wherein the contents of the second instant message are further dependent on the meaning.

24. (Rejected) The signal-bearing media of claim 23, wherein the instructions further comprise:

finding information related to the meaning of the contents of the first instant message; and

building the contents of the second instant message based on the information.

25. (Rejected) The signal-bearing media of claim 22, wherein the location of the sender comprises a location of a hotspot access point.

EVIDENCE APPENDIX

None.

RELATED PROCEEDINGS APPENDIX

None.